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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/809,709  | 03/26/2004  | Shuichi Mafune       | 12065-0011          | 8125             |
| 22902   | 7590        | 06/27/2006           | EXAMINER            |                  |
| CLARK & BRODY<br>1090 VERMONT AVENUE, NW<br>SUITE 250<br>WASHINGTON, DC 20005 |             |                      | WARTALOWICZ, PAUL A |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1754                |                  |

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/809,709

Applicant(s)

MAFUNE ET AL.

Examiner

Paul A. Wartalowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/3/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 of this application conflict with claim 1 of Application No. 10/803963. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

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10/803963. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious that even though Application No. 10/803963 contains a noble element limitation and Application No. 10/809709 does not, the scope of claim 1 in Application No. 10/809709 is encompassed by the scope of claim 1 in Application No. 10/803963 because of the recitation in line 3 of claim 1 in Application No. 10/809709 wherein "a powdery starting material containing". This recitation demonstrates open language and therefore is not limited to the items following said recitation as being contained within a powdery starting material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Yano et al.

(U.S. 2004/0191150).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

U.S. 2004/0191150 teaches a process of producing a perovskite complex oxide comprising a step of heat-treating a precursor substance containing at least one rare earth element and at least one transition metal element to generate a perovskite complex oxide phase, characterized in that an amorphous substance is used as the precursor substance (claim 1).

As to the limitation of R and T components at a content ratio required for producing the complex oxide, U.S. 2004/0191150 teaches a process for making a perovskite complex oxide such that the content ratio is inherently taught.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al. (U.S. 5503815).

Ishii et al. teach a process for making a lanthanum manganite powder (lanthanum manganite powder consists of a single perovskite phase, col. 2, line 65-col. 3, line 4) wherein salts of lanthanum, manganese, and strontium (col. 3, lines 5-10) are dissolved in nitric acid (nitric acid is a hydrogen-generating reducing agent, col. 3, lines 15-20) wherein the dissolved salt mixture is mixed with ammonium carbonate which

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yields a precipitate (col. 3, lines 40-45; col. 4, lines 23-28) and then calcining the reaction product at a temperature of 700°C (col. 4, lines 30-33).

As to the limitation that the precursor substance is an amorphous substance and the limitations of different properties of the final product, the process of the prior art is substantially similar to that of the claimed invention such that the product made by said process and the properties of said product of the prior art are substantially similar to that of the claimed invention.

Claims 1, 3, 8, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Suga et al. (U.S. 6395675).

Suga et al. teach a process for making a double oxide (wherein the double oxide has a perovskite structure, col. 1, line 58-col. 2, line 4) wherein the salts of a lanthanum metal, an alkali metal, and a transition metal are dissolved in water and wherein ammonium hydroxide (ammonium hydroxide is used as the precipitant, col. 5, line 21) is added to precipitate a solid and then drying and baking the solid (col. 5, lines 16-24).

As to the limitation that the precursor substance is an amorphous substance and the limitations of different properties of the final product, the process of the prior art is substantially similar to that of the claimed invention such that the product made by said process and the properties of said product of the prior art are substantially similar to that of the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. (U.S. 5503815) in view of Swinkels et al. (U.S. 4263164).

Ishii et al. teach a process for making a perovskite as described above in claim 1. Ishii et al. fail to teach that the precipitant is a combination of ammonia and carbon dioxide.

Swinkels et al. teach a process for forming a precipitate comprising a lanthanum metal (col. 1, lines 5-8) wherein carbon dioxide and ammonia in combination are used as a precipitant for the purpose of obtaining a precipitate which is easily separated in a customary manner (col. 2, lines 16-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide wherein carbon dioxide and ammonia in

combination are used as a precipitant in Ishii et al. in order to obtain a precipitate which is easily separated in a customary manner (col. 2, lines 16-22) as taught by Swinkels et al.

Claims 2, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suga et al. (U.S. 6395675) in view of Ishii et al. (U.S. 5503815).

Suga et al. teach a process for making a perovskite oxide as described above in claim 1. Suga et al. fail to teach the temperature at which the perovskite complex oxide is calcined, a reducing agent used in the process, the precipitant being an alkaline carbonate, the reducing agent being a hydrogen-generating compound.

Ishii et al., however, teach a process for making a lanthanum manganite powder (lanthanum manganite powder consists of a single perovskite phase, col. 2, line 65-col. 3, line 4) wherein salts of lanthanum, manganese, and strontium (col. 3, lines 5-10) are dissolved in nitric acid (nitric acid is a hydrogen-generating reducing agent, col. 3, lines 15-20) wherein the dissolved salt mixture is mixed with ammonium carbonate which yields a precipitate (col. 3, lines 40-45; col. 4, lines 23-28) and then calcining the reaction product at a temperature of 700°C (col. 4, lines 30-33) for the purpose of carrying out a well-known process of making a perovskite complex oxide with well-known materials and process conditions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide wherein salts of lanthanum, manganese, and strontium (col. 3, lines 5-10) are dissolved in nitric acid (nitric acid is a hydrogen-



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generating reducer, col. 3, lines 15-20) wherein the dissolved salt mixture is mixed with ammonium carbonate which yields a precipitate (col. 3, lines 40-45; col. 4, lines 23-28) and then calcining the reaction product at a temperature of 700°C (col. 4, lines 30-33) in Suga et al. in order to carry out a well-known process of making a perovskite complex oxide with well-known materials and process conditions.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suga et al. (U.S. 6395675) in view of Ishii et al. (U.S. 5503815) and Swinkels et al. (U.S. 4263164).

Suga et al. teach a process for making a perovskite oxide as described above in claim 4. Suga et al. fail to teach wherein the precipitant is a combination of ammonia and carbon dioxide.

Swinkels et al. teach a process for of forming a precipitate comprising a lanthanum metal (col. 1, lines 5-8) wherein carbon dioxide and ammonia in combination are used as a precipitant for the purpose of obtaining a precipitate which is easily separated in a customary manner (col. 2, lines 16-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide wherein carbon dioxide and ammonia in combination are used as a precipitant in Ishii et al. in order to obtain a precipitate which is easily separated in a customary manner (col. 2, lines 16-22) as taught by Swinkels et al.

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**Conclusion**

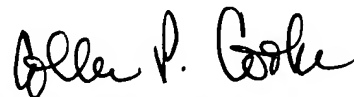
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Wartalowicz whose telephone number is (571) 272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul Wartalowicz  
June 20, 2006



COLLEEN P. COOKE  
PRIMARY EXAMINER